

**REMARKS**

The Office Action dated January 6, 2004, has been received and carefully considered. In this response, claims 47-50 have been added. No new matter has been added. Entry of added claims 47-50 is respectfully requested. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

I. **THE OBVIOUSNESS REJECTION OF CLAIMS 9-32 and 41-46**

On page 2 of the Office Action, claims 9-32 and 41-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffin *et al* (U.S. Patent No. 6,249,769) (hereinafter “Ruffin”) in view of Dan *et al*. (U.S. Patent No. 6,560,639) (hereinafter “Dan”). This rejection is hereby respectfully traversed.

As stated in MPEP §2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680,

16 USPQ2d 1430 (Fed. Cir. 1990). Applicants respectfully submit that the pending rejections fail to make out a *prima facie* case of obviousness.

Independent Claims 9 and 41

Regarding claims 9 and 41, the Examiner asserts that Ruffin discloses: (1) ***“a planning component that gathers information about an infrastructure, a current document handling and delivery system and a methodology used by an entity*** (column 3, lines 57-58, “the present invention provides data gathering facilities for gathering information processing requirements”); (2) ***“an implementation component that provides the entity with a plurality of process maps that provide a plurality of step-by-step instructions for executing the image-based document handling and delivery system*** (column 5, line 7, “a detailed flow diagram”); (3) ***“a control component that provides the entity with a plurality of contingency guidelines and procedures for monitoring and maintaining performance of the executed image-based document handling and delivery system,*** (column 4, lines 4-8, “input is solicited from the qualified customer via a profile template to identify, for each partition, information regarding the current state of each partition and any problems that have been identified for the partition, as well as the future information processing objectives for each partition”); (4) ***“at least one process map of the entity’s existing document handling and delivery system at least a portion of the image-based document handling and delivery system*** (column 8, lines 49-50, “a graphical representation of the interrelationship of these programs and data is presented”); and (5) ***“information on a plurality of document formats for use with the image-based document handling and delivery system*** (column 13, line 8, “Issues/Challenges with current IT infrastructure” and (column 21, line 21, “performance requirements”).”

Applicants respectfully submit that Ruffin fails to teach or suggest at least the above limitations recited in pending claims 9 and 41:

First, Column 3, lines 57-58 of Ruffin does not disclose “a planning component that gathers information about an infrastructure, a current document handling and delivery system and a methodology used by an entity,” but merely discusses data gathering facilities for gathering information processing requirements:

Once a prospective customer has been properly qualified, a further aspect of the present invention provides ***data gathering facilities*** for gathering (for example) information processing requirements coincident with the IT system objectives of an enterprise.

In fact, no mention is made in Ruffin of the gathering of information about an “infrastructure, a current document handling delivery system and a methodology used by an entity.”<sup>1</sup> Without specific disclosure of all claim limitations the Examiner cannot substantiate an obviousness rejection. *See, e.g., In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (All the claim limitations must be taught or suggested by the prior art.); *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

Second, although Applicants agree that Column 5, line 7 of Ruffin discloses “a detailed flow diagram,” Applicants respectfully submit that it does not disclose “an implementation component that provides the entity with a plurality of process maps that provide a plurality of step-by-step instructions for executing the image-based document handling and delivery

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<sup>1</sup> This is not surprising given that Ruffin relates to a system and method for evaluating the business requirements of a business for the purpose of generating business solution deliverables. The claimed invention is wholly distinguishable in that it relates specifically to a system and method for implementing an image-based document handling and delivery system.

system.” Indeed, the flow diagram referenced by the Examiner and disclosed by Ruffin does not recite “step-by-step instructions for executing the image-based document handling and delivery system,” an express recitation of claim 9, for example.

Third, Applicants respectfully submit that Column 4, lines 4-8 of Ruffin does not teach or suggest “a control component that provides the entity with a plurality of contingency guidelines and procedures for monitoring and maintaining performance of the executed image-based document handling and delivery system,” as recited in claim 9, for example, but merely discusses soliciting input via a profile template.

Fourth, Applicants agree that Column 8, lines 49-50 of Ruffin discloses “a graphical representation 400 of the interrelationship between programs and data,” but respectfully submit that it does not disclose “at least one process map of the entity’s existing document handling and delivery system at least a portion of the image-based document handling and delivery system,” as recited in claim 9, for example.

Fifth, Applicants concede that Column 13, line 58 through column 21, line 21 of Ruffin discloses the phrases “Issues/Challenges with current IT infrastructures” and “performance requirements,” but respectfully submit that such disclosures have no relation or relevance to the claimed “information on a plurality of document formats for use with the image-based document handling and delivery system,” as recited in claim 9, for example.

Accordingly, in view of the above arguments Applicants respectfully request that the Examiner reconsider and withdraw the pending rejections based on the Ruffin reference. In addition to the limitation for which the Examiner relies on the Dan reference, Applicants respectfully submit that Ruffin fails to disclose at least the above limitations of pending claim 9, for example, and thus cannot be relied on to support an obviousness rejection. The above

arguments are also applicable to the Examiner's obviousness rejection of claim 41. The dependent claims 10 and 42 are allowable at least by virtue of their dependency on independent claims 9 and 41. Moreover, claims 10 and 42 recite additional subject matter which is not suggested by the prior art references taken either alone or in combination.

Independent Claims 11, 15, 24, and 43

Ruffin's deficiencies are also applicable to the pending obviousness rejections of independent claims 11, 15, 24 and 43 for at least the reasons set forth above. Thus, Applicants request that the pending obviousness rejections of claims 11, 15, 24 and 43 be withdrawn. The dependent claims 12, 13, 14, 16-23, 25-32, 44-46 are allowable at least by virtue of their dependency on independent claims 11, 15, 24 or 43. Moreover, claims 12, 13, 14, 16-23, 25-32, 44-46 recite additional subject matter which is not taught or suggested by the prior art references taken either alone or in combination.

Lack of Motivation to Combine

The Examiner acknowledges that "Ruffin does not teach definition (sic) of each document type with examples of each document type or file name." The Examiner then asserts that "Dan teaches a system and method wherein the information on the plurality of document format comprises: a definition of each of the document types (column 3, line 30-31, "an optional operational manager may create or modify a definition of an object"); one or more examples of information covered by each of the document types (column 3, line 67-column 4, line 2, "each binary file may include a text file, a graphical image, a video image, a data file or an audio file"); and a proposed file name for an imaged version of each of the document types (column 27, lines 3-4, "as long as the asset name remains the same, the user may use any file name to replace it.")

Applicants respectfully submit that Dan fails to teach or suggest at least the above limitation. Dan, for example, relates to a system for web content management based on server-side application, and thus has nothing to do with the claimed systems and methods for implementing an image-based document handling and delivery system. Further, Applicants respectfully submit the Office Action fails to set forth a proper motivation to combine the disclosures of Ruffin and Dan. For example, Ruffin's system and method for evaluating the business requirements of an enterprise for generating business solution deliverables, would not benefit from incorporating Dan's system for web content management based on server-side application. Given such distinct and incompatible subject matter, Applicants submit the cited motivation is improperly based on hindsight from viewing the claims of the present application. Thus, Applicants respectfully submit that the Examiner has not met his burden to establish *prima facie* obviousness.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 9-32 and 41-46 be withdrawn.

## II. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

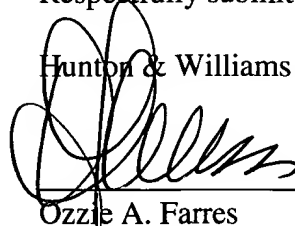
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper,  
including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess  
fees to the same deposit account.

Respectfully submitted,

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Date: June 7, 2004